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Paper 39

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of :
Jean-Francois Bach et al :
Serial No.: 08/986,568 : PETITION DECISION
Filed: December 5, 1997 :
Attorney Docket No.: 040388/0110 :

This is in response to applicants' petition under 35 CFR 1.181, filed September 5, 2002, seeking to invoke the supervisory authority of the Commissioner. The petition has been referred to the attention of the Group Director.

BACKGROUND

This application has an extensive prosecution history which will not be set forth in detail herein. However, the application was forwarded to the Board of Patent Appeals and Interferences (BPAI) for review of the examiner's holding of anticipation and obviousness. In a decision mailed January 9, 2002, the BPAI maintained the anticipation holding of the examiner, albeit for different reasons than the examiner set forth and designated it as a new ground of rejection, but reversed the holding of obviousness. Applicants filed an amendment on March 8, 2002, amending claim 1 and requesting reconsideration of the rejection maintained by the BPAI. On June 11, 2002, based on applicants' decision to resume prosecution before the examiner, the examiner mailed a non-Final Office action to applicants in which, in view of the amendment to claim 1, new rejections were set forth under 35 U.S.C. 112, first paragraph, for lack of description of the invention in the specification; under 35 U.S.C. 112, first paragraph, for lack of enablement of the claimed invention; under 35 U.S.C. 103(a) over Chatenoud et al for obviousness; and under 35 U.S.C. 103(a) over Chatenoud et al in view of Gussow et al for obviousness. A three month shortened statutory period for reply was set.

Applicants replied on December 10, 2002, with an argument, but no claim amendment, to the Office action and this petition.

DISCUSSION

1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and

Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances.

.....

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Inasmuch as this petition was not filed within the two month period specified in 37 CFR 1.181(f) it can be dismissed as untimely. However, the merits of the petition will also be reviewed.

Although the BPAI maintained one of the examiner's rejections upon review it did so for reasons different than those the examiner set forth. As a consequence, the BPAI designated the rejection as a new ground of rejection allowing applicants the option of requesting reconsideration before the BPAI or reopening prosecution before the examiner. Applicants chose the latter and filed within the two month period allotted an amendment of claim 1. Upon review of the amendment the examiner determined that other new grounds of rejection should now be made. The examiner set forth these new grounds of rejection in the Office action mailed June 11, 2002, which was also signed by the Group Director indicating concurrence therewith and approval of the proposed action.

Applicants complain that the prosecution was erroneously reopened following the decision by the BPAI. Applicants, however, chose the venue to proceed with the prosecution of this application - before the examiner - indicating that prosecution was to be reopened. When prosecution is reopened before the examiner following a BPAI decision, it is restricted to only the issues raised by the BPAI unless amendments have been made to the claims. Here, amendments have been made to claim 1 which allowed the examiner to consider all issues pertaining to the patentability of the claimed subject matter. This reopening was further approved by the Group Director wherein the authority lies to reopen prosecution after decision by the BPAI. Thus the examiner did not act of his own volition, but with concurrence of supervisory authority.

Applicants also complain of piecemeal prosecution. While every effort is made to present all rejections and objections to applicants as early in the prosecution as possible so that applicants may have as full and fair an opportunity of addressing them as possible, inadvertently an item may be missed due to misunderstanding or interpretation until a later Office action. This is not considered "piecemeal prosecution", but is part of the thorough review each examiner is to make prior to each Office action. Occasionally such issues arise due to amendments to the claims, although that is not necessarily the case here.

DECISION

Applicants' petition is **DISMISSED** as untimely filed, and further **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the amendment filed December 10, 2002.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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